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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,665	09/02/98	ENDRIKAT J	SCH1637

HM12/0405

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EXAMINER	
QAZI,S	

ART UNIT	PAPER NUMBER
1616	14

DATE MAILED: 04/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/091,665	Endrikat et al.
Examiner	**Group Art Unit**
Sabiha N. Qazi	1616

☒ Responsive to communication(s) filed on *1/19/001*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-35* is/are pending in the application.

Of the above, claim(s) *8-12 and 31-35* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-7 and 13-30* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *8-12 and 31-35* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

Final Office Action on Merits

Invention: Instant invention is drawn to the contraceptive process and administering gestagen, estrogen and/or the combination thereof.

Status of the application

Claims 1-35 are pending.

Claims 1-7 and 13-30 are rejected.

Claims 9-12 are withdrawn from consideration as non elected invention. New claims 31-35 are withdrawn from consideration because these claims would have been restricted if originally presented. It would require separate search due to certain limitations which will be an undue burden on the Examiner.

No claim is allowed.

Response to Arguments

Applicant's arguments were fully considered but are not found persuasive. The basis of the arguments is that the search for the entire invention would not be a burden on Examiner. Examine er respectfully disagree for the following reasons.

Applicants argue that none of the references taken together or separately suggests the instant invention. Furthermore, Applicants argue that in instant invention gestagen is given in the first phase and estrogen id given in the second phase whereas jager in Canadian reference (Jager) gestagen is given after estrogen. Examiner respectfully disagree and would like to draw the attention of Applicants on page 4, lines 10-18 gestagen or estrogen can be used in the first phase.

The reference teaches the combination preparation of estrogen and progestagen which embraces applicant's claimed subject matter.

It would have been obvious to one skilled in the art at the time of invention to use gestagen, estrogen or the combination of both for the conception as instantly claimed particularly when prior art teaches the combination of gestagen and estrogen for the same purpose. There has been ample motivation provided by the prior art to prepare the instant invention. The combination by selection the gestagens and estrogen would have been obvious at the time of invention.

The determination to employ the optimum proportion, duration or combination of the ingredients as cited in claims would have been within the skills of the one familiar with the art. These

numerical limitations of the molar ratios recited in claims of the instant invention do not distinguish the claims over the prior art because they would have been obvious to one skilled in the art in the absence of a showing of criticality, of unobviousness or unexpected results over the prior art.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a). Applicants must show if there is any criticality of their invention over the prior art.

Rejection Maintained

1. Claims 1-7 and claims 13-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Neuman, Friedmund (CA 118:161077, abstract of Pharm. Ztg. (1992), 137(34), 9-15) and over Gast and Koninckx (US Patent 5,747,480 and US 5,827,843) for the same reasons set forth in the office action mailed in paper no. 8, dated 3/29/00.

2. Claims 1-7 and 13-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over de Jager et al. (CA 2000438) for the same reasons set forth in office action mailed in paper no. 11.

Note, that arguments on restriction requirement have addressed in our last office action and restriction was made FINAL.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

4/3/001

SABIHA QAZI, PH.
PRIMARY EXAMINER